


(New) 168. The method of claim 153, wherein the substantially anhydrous cosmetic formulation comprises jojoba glaze, brown iron oxide, titanium dioxide and talc, and wherein the bioactive glass is sol-gel derived.

 (New) 169. The method of claim 153, wherein the substantially anhydrous cosmetic formulation comprises jojoba oil, glyceryl polymethacrylate clathrate and pigment.

(New) 170. The method of claim 153, wherein the substantially anhydrous cosmetic formulation comprises emulsifying wax, mineral oil, glycerin, conditioner, citric acid, colorant and fragrance.

---

#### **REMARKS**

Claims 1-134 were pending. By this amendment, applicants have hereinabove cancelled without prejudice claims 1-134 and have added new claim 135-170. Applicants maintain that this amendment does not raise any issue of new matter. Accordingly, new claims 135-170 are now pending.

#### **Claim Objections**

In the October 9, 2002 Office Action, the Examiner objected to claims 12, 13, 25 and 26 noting that certain then pending dependent claims were separated by claims which did not also depend from the same independent claim.

In response, applicants have hereinabove cancelled without prejudice original claims 1-134 and have submitted new claims 135-170. Pending claims 135-170 conform to the numbering requirements as stated in MPEP § 608.01(n). Accordingly, applicants respectfully request the Examiner withdraw this objection.

**Rejection Under 35 U.S.C. § 112, Second Paragraph**

In the October 9, 2002 Office Action, the Examiner rejected claims 1, 6-14 and 19-26 under 35 U.S.C. § 112, second paragraph stating that these claims were omnibus type claims. In addition, the Examiner rejected claims 1, 14, 93, 102 and 120 stating that these claims recite trademarked items.

In response, applicants have hereinabove cancelled without prejudice original claims 1-134 and have submitted new claims 135-170 obviating the Examiner's rejection under 35 U.S.C. § 112, second paragraph. None of the presently pending claims are in an omnibus form or recite a trademark or trade name.

**Rejection Under 35 U.S.C. § 102(b)**

In the October 9, 2002 Office Action, the Examiner rejected claims 1-5 and 14-18 under § 35 U.S.C. 102(b) as being allegedly anticipated by Shimono's U.S. Patent No. 5,290,544, (hereinafter "Shimono"). The Examiner asserted that Shimono discloses cosmetic products comprising soluble glass, that may be heat-derived or sol-gel derived, wherein the cosmetic products are free from or do not contain water (pointing to col. 1, line 1 through col. 2, line 55, the claims and the abstract).

In response, applicants respectfully traverse the Examiner's rejection under § 35 U.S.C. 102(b). Applicants maintain that the presently pending claims are not anticipated by Shimono. Applicants point out that claims 135 and 153 are the only presently pending independent claims. New claim 135 recites:

A cosmetic composition comprising bioactive glass and a substantially anhydrous cosmetic formulation with the proviso that said bioactive glass does not comprise ions of silver, copper or zinc.

New claim 153 recites:

A method of making a cosmetic composition comprising combining bioactive glass with a substantially anhydrous cosmetic

formulation with the proviso that said bioactive glass does not comprise ions of silver, copper or zinc.

Shimono does not disclose a cosmetic formulation or method of making a cosmetic formulation comprising bioactive glass, that does not also contain ions of silver, copper or zinc. Put differently, each and every time Shimono refers to cosmetic formulations containing particles of soluble glass, such soluble glass contains metal ions, such as silver, copper or zinc. For instance, in the Abstract Shimono states "A cosmetic product is provided which comprises particles of soluble glass ...which contains silver ions... The silver ions provide an anti-bacterial and anti-mold effect for a prolonged period..." (Emphasis supplied.) In the "Background of the Invention" Shimono states that [t]he present invention relates...more particularly to cosmetic products...which contain at least one of Ag<sup>-</sup>, Cu<sup>-</sup>, Cu<sup>-</sup>, and Zn<sup>-</sup>." (Emphasis supplied.) In the "Summary of the Invention" Shimono states that "there is provided cosmetic products containing a soluble glass which contains at least one metal ion of Ag<sup>+</sup>, Cu<sup>+</sup>, Cu<sup>++</sup> and Zn<sup>++</sup> having an antibacterial property." (Emphasis supplied.) In the "Detailed Description" Shimono states that "the cosmetic products of the present invention contain (sic) soluble glass containing at least one metal ion of Ag<sup>+</sup>, Cu<sup>+</sup>, Cu<sup>++</sup> and Zn<sup>++</sup> as an antibacterial agent. Accordingly, such a metal ion is gradually eluted from the soluble glass into the cosmetic products to exhibit an antibacterial effect..." (See, Col. 3, lines 3-8, emphasis supplied.) In addition, none of the Examples provided by the Shimono reference disclose a cosmetic formulation comprising bioactive glass without a metal ion. (See Shimono Examples 1-4.)

Thus, since Shimono does not disclose a cosmetic composition or method of making a cosmetic composition comprising bioactive glass, with the proviso that such bioactive glass does not comprise ions of silver, copper or zinc, Shimono cannot anticipate new claim 135 or 153. Since all other pending claims depend either directly or indirectly from claim 135 or claim 153, those claims are likewise not anticipated by Shimono.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the rejection under § 35 U.S.C. 102(b).

**Rejection Under 35 U.S.C. § 103(a)**

In the October 9, 2002 Office Action, the Examiner rejected claims 1-26, 90-94, 99-103, 120 and 121 under § 35 U.S.C. 103(b) as being allegedly unpatentable over Shimono.

In response, applicants respectfully traverse the Examiner's rejection under § 35 U.S.C. 103(a). Applicants maintain that the presently pending claims are not rendered obvious by Shimono. As stated above claims 135 and 153 are the only presently pending independent claims.

Also as stated above, Shimono does not disclose, teach or suggest cosmetic compositions containing bioactive glass, or methods of making such compositions, with the proviso that bioactive glass does not comprise ions of silver, copper or zinc. In contrast, Shimono discloses and claims compositions with a completely different "soluble glass" that contains metal ions, specifically ions of silver, copper and zinc and functions as a chelator of these particular ions. Shimono states that "the cosmetic products of the present invention contains the soluble glass containing at least one metal ion of  $\text{Ag}^+$ ,  $\text{Cu}^+$ ,  $\text{Cu}^{++}$  and  $\text{Zn}^{++}$  as an antibacterial agent." (See, Shimono col. 3, lines 3-6.) Moreover, Shimono would teach to the reader that compositions which do not contain these ions or some other known antibacterial agent are not suitable for cosmetic products. (See Examples 1-4).

Thus, since Shimono does not disclose, teach or suggest, and in fact teaches away from a cosmetic composition or method of making a cosmetic composition comprising bioactive glass, with the proviso that such bioactive glass does not comprise ions of silver, copper or zinc, Shimono cannot render obvious new claims 135 or 153. Since all other pending claims depend either directly or indirectly from claim 135 or claim 153, those claims are likewise not rendered obvious by Shimono.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the rejection of the claims under § 35 U.S.C. 102(b).

In view of the foregoing, applicants respectfully request that the Examiner reconsider and withdraw the rejections set forth in the October 9, 2002 Office Action and allow the presently pending claims, namely claims 135-170.

Applicant: Lee et al.  
Serial No.: 09/818,466  
Filed: March 27, 2001  
Page 10

No fee, other than the fee for a one-month extension of time, is believed to be necessary in connection with the filing of this Amendment. However, if any additional fee is necessary, applicants hereby authorize such fee to be charged to Deposit Account No. 50-0540.

If a telephone interview would be of assistance in advancing the prosecution of this application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

Respectfully submitted,

Dated: February 10, 2003

By: \_\_\_\_\_



Robert E. Alderson, Jr.  
Registration No. 44,500  
Attorney for Applicants  
KRAMER LEVIN NAFTALIS & FRANKEL LLP  
919 Third Avenue  
New York, New York 10022  
(212) 715-7697